

REMARKS

Claims 1-47 are currently pending, of which claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41 are independent. By this reply, Applicant has amended independent claims 13, 21, 24, 31, 32, 40, and 41. Applicant has also amended paragraph [040] in the specification to more completely identify co-pending U.S. application no. 10/787,206. No prohibited new matter has been added.

In the Office Action,¹ the Examiner rejected claims 13-19 and 32-47 under 35 U.S.C. § 112, ¶ 2 and rejected claims 1-31 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In addition, the Examiner rejected claims 1-47 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,463,421 ("Junger"). Applicant respectfully traverses the rejections for at least the following reasons.

I. Rejection of Claims 13-19 under 35 U.S.C. § 112, ¶ 2

The Examiner rejected independent claim 13 and dependent claims 14-19 under 35 U.S.C. § 112, ¶ 2 because there is allegedly insufficient antecedent basis for the phrase "the pending delivery record" in the claims. Although Applicant does not acquiesce to the rejection, in order to advance prosecution, Applicant has amended independent claim 13 to remove the phrase "the pending delivery record." Accordingly, reconsideration and withdrawal of the rejection of claims 13-19 is respectfully requested and believed appropriate.

¹ The Office Action contains a number of statements reflecting characterizations of the specification, claims, and related art. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

The Examiner rejected independent claims 32, 40, and 41 as allegedly being “vague and indefinite.” Office Action at 2. To address the Examiner’s concerns, Applicant has amended the preamble of claim 32 to recite “A system for managing a return of a product, the [[method]] system comprising” and amended the preambles of claims 40 and 41 to recite “A system for managing a product return, the [[method]] system comprising.” In view of these amendments, Applicant submits that the rejection of claims 32, 40, and 41 is moot and should be withdrawn.

II. Rejection of Claims 1-20 under 35 U.S.C. § 101

The Examiner rejected claims 1-20 under 35 U.S.C. § 101 because each claim allegedly “does not transform the underlying subject matter and the process is not tied to another statutory class.” Office Action at 3. Applicant respectfully disagrees and submits that each of the claims are directed to statutory subject matter. First, independent claims 1, 9, 13, and 20 are tied to another statutory class in that each relates to a method and recites one or more steps that is tied to a product, a management system, and/or a database. Such physical apparatuses are clearly statutory and tied to the claimed methods. Second, independent claims 1, 9, 13, and 20 include the step of “creating” a record in a management system or database.² The recited “creating” steps inherently transform the underlying subject matter (i.e., a management system or a database) such that records are brought into existence in the

² Independent method claims 1, 9, 13, and 20 recite, for example, “creating a record in a second management system” (claim 1); “creating at least one record in each of a plurality of management systems” (claim 9); “creating in a first database a return authorization record” (claim 13); “creating a record for the product return in a second database” (claim 20).

respective physical apparatus. The U.S. Patent and Trademark Office has held that the transformation of physical subject matter, such as recited in claims 1, 9, 13, and 20, is statutory under Section 101. See, e.g., Ex Parte Bilski, Appeal No. 2002-2257 (September 26, 2006) at 27 (“Where the steps define a transformation of physical subject matter (tangible or intangible) to a different state or thing, as normally present in chemical, electrical, and mechanical cases, there is no question that the subject matter is statutory”). Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-20.

The Examiner rejected claims 21-31 under 35 U.S.C. § 101 for allegedly covering non-statutory electromagnetic carrier waves. Office Action at ¶ 4. Although Applicant does not acquiesce to the rejection, in order to advance prosecution, Applicant has amended independent claims 21, 24, and 31 to clarify that the claimed “computer readable medium” includes “a memory containing instructions” Accordingly, claims 21, 24, and 31, as presently amended, and their dependent claims 22, 23, and 25-30, require “a memory” that is not merely drawn to a form of electromagnetic energy and is statutory in accordance with Section 101. See, e.g., M.P.E.P. § 2106.01. The Examiner, therefore, is respectfully requested to reconsider and withdraw the rejection of claims 21-31.

III. Rejection of Claims 1-47 under 35 U.S.C. § 102(b)

Applicant respectfully traverses the rejection of claims 1-47 under 35 U.S.C. § 102(b) in view of Junger. In order to properly establish an anticipation rejection under 35 U.S.C. § 102, every element of the claims at issue must be found in the applied prior-art reference, either expressly or under principles of inherency. Furthermore, “[t]he

identical invention must be shown in as complete detail as is contained in the ... claim.”

See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). In this case, Junger fails to teach or suggest every element of Applicant’s claims.

Junger relates to a “method and apparatus for efficient handling of product returns.” Junger, Abstract. Junger discloses that a return authorization number “may be written on an adhesive label supplied by the manufacturer along with the customer reference number (if applicable),” or alternatively a “printer 216 (FIG. 2) may be used to print labels upon receipt of a return authorization number.” Junger, col. 8, ll. 55-60. The labels including the return authorization number “are preferably placed on all four sides of the shipping pallet.” Junger, col. 8, ll. 60-61. In this manner, “[t]he return authorization labels provide an easy reference to personnel at the manufacturer warehouse and permit simple and efficient processing of the returned.” Junger, col. 8, line 66 – col. 9, line 1.

In the system of Junger, a return center operator submits a return authorization request to the manufacturer’s system. See, e.g., Junger, FIG. 4G; col. 8, ll. 5-10. If the manufacturer approves the request, the manufacturer’s system returns a “RA Status” display screen showing, among other things, the return authorization number for the return. See, e.g., Junger, FIG. 4H (“RA Number”); col. 8, ll. 33-41. As indicated above, the return authorization number is placed on the returned products prior to shipping to provide an easy reference for the personnel at the manufacturer’s warehouse. See, e.g., Junger, col. 8, line 66 — col. 9, line 1.

The return authorization number, or RA number, in Junger is used for record keeping only at the manufacturer and not by any other entity. For instance, while the manufacturer uses the return authorization number to track returned products, the product return center instead uses “a customer number (e.g., a bill of lading number, file number, invoice number, etc.) [that] may be entered for an internal reference to identify the return authorization.” Junger, col. 7, ll. 64-67. Because the return authorization number in Junger is only used for record keeping at the manufacturer side (i.e., in a single manufacturer database or system), the return authorization number in Junger is not used in more than one database or management system. Further, while the manufacturer side 23 in Junger uses the return authorization number to identify a batch of returned products, the corresponding return side 21 instead uses a customer number reference to identify the same set of returned products. The return side 21 does not issue a return authorization number or RAN and, therefore, does not anticipate the “issuing” step or “first management system” of claim 1, as incorrectly asserted on page 5 of the Office Action.

Junger does not teach or suggest claim 1 for at least the reasons noted above and, furthermore, does not anticipate each of the independent claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41 because it does not disclose a return authorization number or other “unique identifier” that is used in a plurality of different databases or systems, as required the claims. In particular, since the return authorization number in Junger is only used for record keeping in a single manufacturer side portion 23, Junger fails to disclose or suggest at least “a return authorization number” used in both “a first management system” and “a second management system,” as recited in independent

claim 1, “a plurality of management systems” that each have a record with a “unique identifier,” as recited in independent claims 9 and 31, or “a first database” and “a second database” that each have a record with a “return authorization number,” as recited in independent claims 13, 20, 24, and 32. In addition, Junger fails to disclose or suggest at least “a customer relationship management (CRM) system” and “a warehouse management (WM) system” that each has a record with a “return authorization number,” as recited in independent claim 21, “a plurality of databases” each with a record uniquely associated with a “RAN,” as recited in independent claim 40, or “a first computer” and “a second computer” that each has a record with a “return authorization number,” as recited in independent claim 41.

For at least the foregoing reasons, Applicant submits that independent claims 1, 9, 13, 20, 21, 24, 31, 32, 40, and 41 are allowable over Junger. In addition, dependent claims 2-8, 10-12, 14-19, 22, 23, 33-39, and 42-47 are allowable at least in view of their dependence on independent claims 1, 9, 13, 20, 21, 24, 31, 32, 40, or 41.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

The preceding remarks are based only on the arguments in the pending Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the

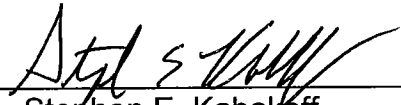
preceding remarks in favor of patentability are advanced without prejudice to other possible bases of patentability.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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